

A. 35 U.S.C. § 103 Rejection based on DE 2703189 and U.S. Patent No. 5,578,312 in view of DE 2732749 and CN 1033278:

In the Office Action dated 5 November 2001, DE 2703189 (DE '189), US 5,578,312 (Parrinello), DE 2732749 (DE '749) and CN 1033278 (CN '278) were combined to render obvious claims 1-9, 13-23, 27 and 28. While not conceding the obviousness of claims 1-4, 6-9, 27 and 28, Applicant has, at this time, cancelled these claims. With respect to claims 5 and 13-23, Applicant respectfully submits that the prima facie case of obviousness has not been met.

Specifically, applicant submits that 1) there is no suggestion or motivation *in the references themselves* to modify the reference or to combine reference teachings; 2) there is no suggestion or motivation *in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings; 3) there is no reasonable expectation of success; and 4) the prior art references do not teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Therefore, Applicant requests that the remaining claims be allowed.

1. The prior art references do not teach or suggest the claim limitations.

Applicant respectfully submits that the prior art references do not teach or suggest a skin care product having a ginseng *berry* extract (as in claims 5 and 13). Reference DE '189 discloses an anti-wrinkle cream containing "plant and vegetable extracts and natural ingredients only." Juice from the cactus species *Opuntia reginae* appears to be one of the plant extracts. Parrinello discloses a skin care system that includes a biogenic hydrating water complex, a moisturizing lotion and a cleanser containing "ginseng" as one of several ingredients.

As illustrated in Applicant's response to the August 29, 2000 communication from the Examiner, the term "ginseng" in the prior art refers to the *root* and not the *fruit* of the plant.

Specifically, Applicant refers to the dictionary definition of the term ginseng: 1) an herb with a thick, forked, aromatic *root*, and 2) the *root* of this plant used medicinally by the Chinese.

Response to Office Action, mailed November 17, 2000, at page 10. Moreover, referring again to the research conducted regarding the normal and traditional usage of the term “ginseng,” it is clear that those skilled in the art traditionally consider the term “ginseng” to refer to the root and not to the berry. *Id* at page 11.

Inasmuch as “ginseng” means ginseng root, Applicant respectfully asserts that the element “ginseng berry extract” is not taught in either of these references.

The references DE ‘749 and CN ‘278 also fail to teach or suggest Applicant’s particular ginseng berry extract. Admittedly, CN’ 278 discusses a process for extracting triterpenoid glycoside from ginseng berries, which arguably may be termed an “ginseng berry extract.” However, Applicant respectfully submits that the “extract” taught in CN ‘278 is significantly different from the ginseng berry extract taught in applicant’s invention. Specifically, as stated in Applicant’s application, “[w]hole ginseng berries are squeezed in a press creating a somewhat pulpy extract.” *** “After juice has been extracted, it is blended with other natural ingredients which add other nutritional and psychological benefits.” Application at pp. 10-11. Clearly, Applicant’s extract is more than isolated triterpenoid glycoside. Referring to Table 4 in the present application, Applicant’s extract is a juice and pulp mixture that includes riboflavin, vitamins A and E as well as beta carotene. Applicant’s ginseng berry extract also acts as an anti-oxidant. Application at page 10. Inasmuch as the cited prior art references do not teach or suggest all the claim limitations, Applicant respectfully requests that the obviousness rejection be withdrawn.

2. There is no suggestion or motivation in the references themselves to modify the reference or to combine reference teachings

In the Office action, dated November 5, 2001, it was suggested that Parrinello teaches the moisturizing effect of ginseng. “[C]hoosing a suitable type of extract (of ginseng) without sacrificing the moisturizing effect of the extract would have been within the scope of a skilled artisan *because the prior art teaches the moisturizing effect in ginseng extract.*” Office Action at page 4. This assumption, it appears, was the basis for combining Parrinello with DE ‘189.

“Parrinello teaches ginseng extract.... Parrinello does not teach cactus fruit extract. However, it would have been obvious for a skilled artisan...to add the cactus fruit juice of DE ‘189 to the skin moisturizing composition of Parrinello...because, DE ‘189 teaches cactus fruit is effective for skin wrinkles and can be combined with other natural ingredients and Parrinello also teaches all natural extracts for moisturizing skin and removing wrinkles.” Id.

Applicant respectfully disagrees that the Parrinello reference teaches the “moisturizing effect” of ginseng. Admittedly, Parrinello teaches the use of ginseng in a moisturizer. U.S. Patent No. 5,578,312, col. 5, line 48. However, this reference does not teach that ginseng acts as an active ingredient in the moisturizer. In fact, there is no particular mention at all as to what role the ginseng plays in the Parrinello system. Ginseng is also listed as an ingredient in a *cleanser* (col. 2, line 53), and as part of a *biogenic hydrating water complex* (col. 7, line 6).

Inasmuch as ginseng root is aromatic (see dictionary definition above), it is equally plausible that ginseng is added merely as a fragrance. For example, essential oils are added to the moisturizer and cleanser “to give the composition a pleasant aroma which can stimulate the user’s appetite.” Id at col. 2, lines 58-60.

Applicant respectfully submits that since the purpose of the ginseng is not taught in Parrinello, it cannot be assumed that a skilled artisan would know to combine ginseng with cactus fruit extract on account of the “moisturizing effect” of ginseng. Accordingly, Applicant respectfully asserts that the combination of Parrinello with DE ‘189 was improper. Therefore, Applicant requests that the obviousness rejection be withdrawn.

Applicant further argues, with respect to DE ‘749, that this reference does not teach triterpenes being present in ginseng roots. Specifically, in the Office Action, dated November 5, 2001, it was stated that “DE 2732749 and CN ‘278 teach triterpenes are present in ginseng root and ginseng fruit respectively.” Office Action at page 4. However, upon a closer reading of DE ‘749, there is in fact no teaching of triterpenes being present in ginseng root. Rather, according to the title, the process involves “linking dammarene-type tri:terpene alcohol(s) from plant, [especially] birch leaves with sugar residues.” DE 2732749. This process creates saponins “which correspond to saponins [obtained] from ginseng root.” Therefore, this reference only teaches that triterpenes are present *in birch leaves*, and that these triterpenes can be reacted with sugar residues to synthesize a ginseng-like saponin. Id.

Accordingly, Applicant respectfully asserts that the combination of Parrinello and DE ‘189 with DE ‘749 was improper. Therefore, Applicant requests that the obviousness rejection be withdrawn.

3. There is no suggestion or motivation in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings

In combining the references CN ‘278 and DE ‘749 with Parrinello and DE ‘189, it was argued that since CN ‘278 and DE ‘749 both teach the presence of triterpenes in both the roots

and berries, "it would have been obvious for a skilled artisan at the time of the instant invention to use either ginseng root (CN '278) or ginseng fruit (DE '749) in the composition of Parrinello and still expect the same anti-wrinkling and skin-moisturizing activity of the composition."

Office Action at page 4.

Applicant submits that such a statement impermissibly ignores the inherent difficulty of using the berries. As noted in the present application, due to their small size and high seed content, the fruits have been overlooked as an herbal supplement. Application at page 9. This is further evidenced by the widespread use of ginseng root, but the virtual absence of any practical application of ginseng berry (Applicant again refers Examiner to the research accompanying its response to Paper No. 4).

Therefore, Applicant respectfully submits that the knowledge generally available to one of ordinary skill in the art, does not teach or suggest the modification or combination of references proposed in the November 5, 2001 Office Action.

4. There is no reasonable expectation of success

Applying similar reasoning as outlined above, in light of the high seed content and small size of the ginseng berries, Applicant submits that there would be no reasonable expectation of success in combining the references as proposed in the November 5, 2001 Office Action.

B. Other Evidence of Allowability

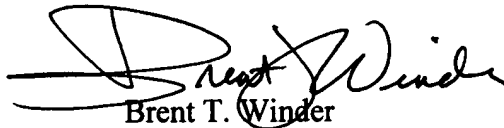
As additional support for the allowability of Applicant's present claims, it is noted that the Related Application Nos. 09/298,703 and 09/298,807 filed concurrently with the present application, have been allowed claiming health promoting compositions including cactus fruit extract and ginseng berry extract. Applicant submits that such allowance evidences the novelty of Applicant's present invention in multiple medicinal applications.

CONCLUSION

In view of the foregoing, Applicant believes that the remaining claims are in a condition for allowance, and respectfully requests the same. It is believed that the foregoing changes find support in the specification and accordingly are not new matter.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"VERSION WITH MARKINGS TO SHOW CHANGES MADE."** Should the Examiner wish to discuss any of the proposed changes or any other issue regarding this response, Applicant invites her to do so by telephone conference.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brent T. Winder", is written over a horizontal line.

Brent T. Winder
Attorney for Applicant
Registration No. 46,250

JONES, WALDO, HOLBROOK & McDONOUGH
170 South Main Street, Suite 1500
Salt Lake City, Utah 84101-1644
Telephone: (801) 521-3200
Facsimile: (801) 328-0537



COPY OF PAPERS
ORIGINALLY FILED

Original Docket No. 7537.29
New Docket No. 13246.0007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Jau-Fei Chen)	
)	
Application No.:	09/298,245)	Examiner: Lakshmi Channavajjala
)	
Filed:	23 April 1999)	Group Art Unit: 1615
)	
For:	CACTUS FRUIT SKIN CARE PRODUCTS)	Docket No. 13246.0007
)	

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend the following claims:

5. (Amended) [The skin care product of claim 1 further comprising] A skin care product
comprising:

- a) a cactus fruit extract;
- b) a natural skin supplement; and
- c) ginseng berry extract.

RECEIVED
MAR 20 2002
TECH CENTER 1600/2900